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10/620,959

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EXAMINER

KATCHEVES, BASIL S

ART UNIT

PAPER NUMBER

3635

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/620,959 | <b>Applicant(s)</b><br>GORDIN ET AL. |  |
|                              | <b>Examiner</b><br>BASIL KATCHEVES   | <b>Art Unit</b><br>3635              |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-16,18-57,59-74 and 76-89 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-16,18-24,28-57,59-61,65-74,76-78 and 82-89 is/are rejected.
- 7) ☒ Claim(s) 25-27,62-64 and 79-81 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Pending claims 1, 3-16, 18-57, 59-74 and 76-89 are examined below.

#### ***Claim Objections***

Claims 13, 16, 21, 23, 24, 60 are objected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 states "vinyl/acrylic". This renders the claim(s) indefinite because the claim(s) include(s) elements not actually thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claims 13, 21, 24 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 23 and 60 state the sheet does not overlap but their independent claims state the "are adjacent or overlapping".

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3-16, 18, 19, 21, 31-50, 52-54, 56, 73 are rejected under 35 U.S.C.**

**103(a) as being unpatentable over U.S. Patent No. 6,340,790 to Gordin et al. in view of U.S. Patent No. 4,019,301 to Fox.**

Regarding claim 1, 3, 4, 5, 7, 36, 42, 43, 44, 45, 54, 56, 73, Gordin discloses a substantially hollow, tubular, steel, tapered, elongated metal pole (fig. 11: 92) which holds lighting. However, Gordin does not disclose a plastic independent covering substantially around the whole pole. Fox discloses wrapped plastic sheets (figs. 5 and see plurality of sheet members in fig. 6), having opposite edges connected (fig. 6), covering a substantial portion of metal structural members (secured from movement). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gordin by adding the protective plastic covering of Fox in order to prevent corrosion. Regarding the claimed thicknesses of the cover and pole, Fox and Gordin disclose the basic claim structure of the instant application but does not disclose specific dimensions. Applicant fails to show criticality for specifically claimed dimensions, therefore it would have been an obvious design choice to use the

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dimensions such as specified in these claims. Also, the applicant should note that a combination of Gordin with Fox would result in a trapezoidal sheet shape since the pole of Gordin is conical and tapered.

Regarding claim 6, 9, Gordin discloses the pole as slip fitted to a base (fig. 11: see slip fit over concrete base).

Regarding claim 8, Gordin discloses the pole as comprising a plurality of sections (fig. 7: 72& 76).

Regarding claim 10, Fox discloses an independent covering layer for different sections of metal pipe (fig. 6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an independent cover for each tubular member, as disclosed by Terrels, in order to ease installation.

Regarding claims 11, 12, overlapping cover layers would naturally occur as, shown in figure 7 of Gordin, since the poles overlap, where one part overlaps a preceding part (see stacked fig. 7 of Gordin).

Regarding claim 13, Fox discloses a sheet of material surrounding the pole in a wrapped manner.

Regarding claims 14-16, 50, Fox discloses the use of a vinyl (inherently flexible) material (column 3: lines 7-14). Fox does not specifically disclose the use of a vinyl/acrylic alloy. However, Fox discloses the use of plastic materials which resist corrosion. Plastic, as cited in Fox, is used for a variety of synthetic components and a vinyl/acrylic alloy is a plastic resistant to corrosion and, therefore, would be a functional equivalent making its use an obvious design choice.

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Regarding claim 18, Fox discloses the basic claim structure of the instant application but does not disclose the dimension of approximately .04 inches thick. Applicant fails to show criticality for specifically claimed dimensions, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims.

Regarding claim 19, Fox discloses the cover as having top, bottom and sides.

Regarding claim 21, 47, 48, Gordin in view of Fox would inherently have a trapezoidal shaped cover (when unrolled) since the cover of a tapered pole would have to be trapezoidal.

Regarding claim 31, 32, 49, Fox discloses an opening (top and bottom) in the covering layer which would fit (overlap) over the pole.

Regarding claims 33-35, 52, Fox discloses a sealing element around the pole (fig. 9: 128), the sealing element is not particularly disclosed as caulk but is disclosed as a compressible material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Fox by using caulk, as caulk would be a functional equivalent of a compressible material for preventing moisture intrusion.

Regarding claims 37-41, 53, Fox discloses the cover as inherently having a color, a texture and a pattern of a plastic material. An obvious design choice would be to paint the cover with any appropriate color.

Regarding claim 46, the height of the pole would be an obvious design choice dependant upon the intended use of the pole.

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**Claims 20, 22-24, 51, 55, 57, 59-61, 65-78, 82-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,340,790 to Gordin et al in view of U.S. Patent No. 4,019,301 to Fox further in view of U.S. Patent No. 3,968,561 to Oakes et al.**

Regarding claims 20, 51, Gordin in view of Fox does not disclose the sleeves, when laying flat, as having the opposite side edges rolled into a U shape. Oakes discloses a pole sleeve having opposite edges rolled into a U shape (fig. 2: 21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gordin in view of Fox by using the U shaped ends of Oakes in order to secure the sleeve around the pole in a tighter crimped manner.

Regarding claim 22, Gordin in view of Fox discloses the sleeve as being in a trapezoidal shape when in a flat configuration, since Gordin disclose the sleeve as a truncated cone shape. Further in view of Oakes, as above, would include rolled edges (as disclosed by Oaks in the rejection of claim 20).

Regarding claim 23, Gordin in view of Fox does not disclose side edges (Fox: fig. 7: 90, 92, 88) as overlapping.

Regarding claim 24, Fox discloses a fastener (fig. 8: 102, 108) for securing the sheet around the pole.

Regarding claim 55, claim 55 is rejected for reasons cited in the rejection of claim 51. In addition, the rolled edge of Oakes appears act as a fastener.

Regarding claim 59, 67, 76, 84, Gordin discloses a substantially hollow, tubular, steel, tapered, elongated metal pole (fig. 11: 92) which holds lighting. However, Gordin

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does not disclose a plastic independent covering substantially around the whole pole.

Fox discloses wrapped plastic sheets (fig. 6) for covering metal members (secured from movement). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gordin by adding the protective plastic covering of Fox in order to prevent corrosion. Regarding the claimed thickness of the cover and pole, Fox and Gordin discloses the basic claim structure of the instant application but do not disclose specific dimensions. Applicant fails to show criticality for specifically claimed dimensions, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims. Gordin in view of Fox does not disclose the sleeves as having the opposite side edges rolled into a U shape. Oakes discloses a pole sleeve having opposite edges rolled into a U shape (fig. 2: 21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gordin in view of Fox by using the U shaped ends of Oakes in order to secure the sleeve around the pole in a tighter crimped manner.

Regarding claim 57, 74, the height of the pole would be an obvious design choice dependant upon the intended use of the pole.

Regarding claim 60, 77, Fox discloses the sides (88, 90, 92) as adjacent but not overlapping.

Regarding claim 61, 78, Fox discloses a fastener (108) for securing the cover.

Regarding claims 65, 66, 82, 83, Gordin in view of Fox further in view of Oakes does not disclose the use of a screw passing through the cover to secure it. It would have been obvious to one having ordinary skill in the art at the time the invention was



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made to use a screw to secure the cover, since screws are typically used to screw through something and secure them to a second element.

Regarding claims 68-72, 85-89, Fox discloses the cover as inherently having a color, a texture and a pattern of a plastic material. An obvious design choice would be to paint the cover with any appropriate color.

**Claims 28, 29, 30, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,340,790 to Gordin et al in view of U.S. Patent No. 4,019,301 to Fox further in view of U.S. Patent No. 4,092,079 to Swanson.**

Regarding claim 28 Gordin in view of Fox does not disclose the use of fasteners. Swanson discloses a sleeve for a pole using fasteners to secure the sleeve (fig. 5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gordin in view of Fox by using fasteners, as disclosed by Swanson, in order to better secure the sleeves.

Regarding claim 29, Swanson discloses the use of screws (49).

Regarding claim 30, Swanson discloses bolts (49) and nuts (51).

### **Claim Objections**

Claims 25, 62 and 79 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 26, 27, 63, 64, 80 and 81 are objected to for depending from 25, 62 and 79.

### **Response to Arguments**

Applicant's arguments filed 3/17/08 have been fully considered but they are not persuasive. The applicant argues the combination of Gordin in view of Fox. Gordin discloses a hollow tapered pole of more than one section and Fox discloses a means of preventing corrosion to poles by using a plastic wrap around the structure. The applicant argues that Fox requires the use of filler between the cover and metal. However, this is not necessary as Fox states in the abstract that the wrap is for wood, steel or other structures. Applicant also argues the rigidity of Fox. The applicant should note that it is of a material that has an inherent flexibility and even though it has a level of rigidity, it is also substantially flexible. The applicant argues the method steps of the application. This is addressed in the rejection of the article claims as an obviousness rejection. The applicant argues that Fox is not in two or more sections. Figure 6 shows three sections. The applicant argues the Swanson reference, the Swanson reference requiring a rigid cylinder. The applicant should note that Swanson discloses a means for securing sleeves around poles, the means being combined with the prior art to better secure the sleeve as stated in the

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rejection above. Applicant argues the Oakes reference teaches the rolled edge connection of a pole wrap. This art is analogous and is a standard means of connection, the combination of which is explained in the rejection above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Basil Katcheves whose telephone number is (571) 272-6846. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot, can be reached at (571) 272-6777.

/Basil Katcheves/

Primary Examiner, Art Unit 3635